



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/525,905

08/22/2005

Naomi Urano

450100-04739

9662

22852

7590

09/12/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SU, SARAH

ART UNIT

PAPER NUMBER

2131

MAIL DATE

DELIVERY MODE

09/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/525,905 | Applicant(s) URANO ET AL. | |
| | Examiner Sarah Su | Art Unit 2131 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 12-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/25/05, 2/8/07, 8/1/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are presented for examination.

Priority

2. The claim for priority from PCT/JP03/10823 filed on 27 August 2003 is duly noted.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement filed 25 February 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because an English translation has not been included with the foreign documents JP 11-31130 and JP 2002-197069. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification

5. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

6. Claims 6-8, and 12-15 are objected to because of the following informalities:
- a. In claims 6-8, line 12: "the processing" lacks antecedent basis;
 - b. In claim 12, lines 3-4: "a usage-condition determination module" is unclear if it relates to "a usage-condition determination module" (claim 9, lines 14-15);
 - c. In claims 13-15, line 7: "the processing" lacks antecedent basis;
 - d. In claims 13-15, line 14: "the processing" lacks antecedent basis.

Appropriate correction is required.

Drawings

7. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

Art Unit: 2131

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-8 and 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to a computer program per se. Computer programs claimed as computer listings per se are abstract instructions. Computer programs are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. As such, these claims are not directed to one of the statutory categories of invention (See MPEP 2106.01), but are directed to nonstatutory functional descriptive material.

Please note that computer programs embodied on a computer readable medium or other structure, which would permit the functionality of the program to be realized, would be directed to a product and be within a statutory category of invention, so long as the computer readable medium is not disclosed as non-statutory subject matter per se (electromagnetic signals or carrier waves).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 9-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Harada et al. (US 2003/0007640 A1 and Harada hereinafter).

As to claims 9 and 13-15, Harada discloses a system and method for digital work protection, the system and method having:

storage means for storing the digital content (0083, line 1);

acquisition means for acquiring the usage-condition information corresponding to the digital content stored in the storage means from a server via a network (0225, lines 1-3);

determination means for determining whether the digital content can be played back based on the usage-condition information (0012, lines 4-6);

playback control means for controlling the playback of the digital content according to a determination result by the determination means (0013, lines 5-6),

wherein the determination means includes a usage-condition determination module (i.e. usage condition judgment unit) corresponding to each of at least one item included in the usage conditions (0229, lines 1-5).

As to claim 10, Harada discloses:

wherein an item in the usage conditions includes at least one of an allowed playback period, a number of permitted uses, a body temperature, a pulse rate, and a blood pressure of a user, a temperature, a humidity, a longitude, a latitude, and an altitude of an operating location, an acceleration and a pressure applied to the information processing apparatus, and an authentication of the user (0225, lines 8-9).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2131

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harada as applied to claim 9 above, and in view of Seeman (US 2003/0200459 A1).

As to claim 11, Harada does not disclose:

wherein the usage-condition determination module is plug-in format software.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Harada, as evidenced by Seeman.

Seeman discloses a system and method for protecting documents while maintaining editability, the system and method having:

wherein the usage-condition determination module is plug-in format software (0006, lines 4-8).

Given the teaching of Seeman, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Harada with the teachings of Seeman by using a software plug-in for the determination module. Seeman recites motivation by disclosing that storing usage rights on a separate server and using a plug-in to access data is appropriate for corporate digital rights management (0006, lines 1-5). It is obvious that the teachings of Seeman would have improved the teachings of Harada by using a plug-in software in order to accommodate for corporate implementation of digital rights management.

Art Unit: 2131

As to claim 12, Harada does not disclose:

request means for making a request to the server for a usage-condition determination module corresponding to the usage-condition information via the network.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Harada, as evidenced by Seeman.

Seeman discloses:

request means for making a request to the server for a usage-condition determination module (i.e. Authentica plug-in) **corresponding to the usage-condition information** (i.e. usage rights) **via the network** (i.e. from policy server) (0006, lines 3-8). The examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made that since plug-ins are additions to a program, the plug-ins can be received either together or separate from the program.

Given the teaching of Seeman, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Harada with the teachings of Seeman by requesting a determination module from a network. Please refer to the motivation recited above in respect to claim 11 as to why it is obvious to apply the teaching of Seeman to the teaching of Harada.

Art Unit: 2131

14. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US Patent 5,634,012 and Stefik hereinafter) and in view of Ta et al. (US 2003/0009424 A1 and Ta hereinafter).

As to claims 1 and 6-8, Stefik discloses a system and method for controlling the distribution and use of digital works having a fee reporting mechanism, the system and method having:

setting means for setting usage conditions for the digital content and generating the corresponding usage-condition information (col. 7, lines 8-9);

storage means for storing the usage-condition information by associating the usage-condition information with the digital content (col. 7, lines 9-10);

supply means for supplying the client terminal with the usage-condition information stored by the storage means via the network in response to a request from the client terminal (col. 7, lines 19-30).

Stefik does not disclose:

wherein the setting means includes a usage-condition setting module corresponding to each of at least one item included in the usage conditions.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Stefik, as evidenced by Ta.

Ta discloses a system and method for managing access and use of resources, the system and method having:

wherein the setting means includes a usage-condition setting module (i.e. application) corresponding to each of at least one item (i.e. state) included in the usage conditions (0040, lines 9-17).

Given the teaching of Ta, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Stefik with the teachings of Ta by setting usage conditions. Ta recites motivation by disclosing that associating conditions with various states of a resource provides content owners a flexible way to protect different types of resources (0018, lines 7-9). It is obvious that the teachings of Ta would have improved the teachings of Stefik by associating conditions with different states in order to provide flexibility of content protection.

As to claim 2, Stefik discloses:

wherein an item in the usage conditions includes at least one of an allowed playback period, a number of permitted uses, a body temperature, a pulse rate, and a blood pressure of a user, a temperature, a humidity, a longitude, a latitude, and an altitude of an operating location, an acceleration and a pressure applied to the client terminal, and an authentication of the user (col. 22, line 46; col. 23, lines 37-39).

As to claim 5, Stefik discloses:

wherein the network is the Internet (col. 1, lines 45-46).

Art Unit: 2131

As to claim 3, Stefik does not disclose:

wherein the usage-condition setting module is plug-in format software.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Stefik, as evidenced by Seeman.

Seeman discloses:

wherein the usage-condition setting module is plug-in format software (0006, lines 4-8).

Given the teaching of Seeman, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Stefik with the teachings of Seeman by using a software plug-in.

Please refer to the motivation recited above in respect to claim 11 as to why it is obvious to apply the teachings of Seeman to the teachings of Stefik.

As to claim 4, Stefik does not disclose:

providing means for providing the client terminal with a usage-condition determination module corresponding to the usage-condition information via the network.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Stefik, as evidenced by Seeman.

Seeman discloses:

providing means for providing the client terminal with a usage-condition determination module corresponding to the usage-condition information via the network (0006, lines 3-8). The examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made that since plug-ins are additions to a program, the plug-ins can be provided either together or separate from the program.

Given the teaching of Seeman, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Stefik with the teachings of Seeman by providing a determination module through a network. Please refer to the motivation recited above in respect to claim 11 as to why it is obvious to apply the teachings of Seeman to the teachings of Stefik.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2131

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Su/
Examiner, Art Unit 2131

/Christopher A. Revak/

Primary Examiner, Art Unit 2131